

APPENDIX A

Docket No. 455-024

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

JEFFREY S. KIEL ET AL.

Serial No.: 10/806,022

: Group Art Unit: 1625

Filed: 03/22/2004

: Examiner: Oh, Taylor V.

For: PROCESS FOR PREPARING
PHENOLIC ACID SALTS OF GABAPENTIN

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Feb. 23, 2006
Date of Deposit

SANDY WILLIAMS
Name of Depositor

Sandy Williams
Signature of Depositor

RESPONSE

Mail Stop Amendment
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant has fully reviewed the Office Action mailed September 26, 2005, and appreciates the Examiner's comments therein. As a preliminary matter, Applicant hereby petitions for a two month extension of time under 37 C.F.R. 1.136(a), and files herewith a USPTO form PTO/SB/22, therein extending the deadline for responding to February 26, 2006.

The Action rejects claim 1 under 35 U.S.C. §102(b) in view of U.S. Patent App. Pub. No. US 2003/0077321 to Kiel et al. (the "'321 publication"), published *April 24, 2003*. The Action also relies on the '321 publication to reject claims 1, 2, and 5-21 under 35 U.S.C. §103(a).

Applicant respectfully submits that the present application was filed *March 22, 2004*, and claims priority to a provisional application filed *March 25, 2003*. Since the '321 publication was published after Applicant's provisional application and less than one year from the date of the non-provisional filing, it is simply not prior art under 35 U.S.C. §102(b) or 103(a). Moreover, since the inventors of the '321 publication and the present application are identical, the '321 publication was not described in a published application by "another," and 35 U.S.C. §102(e) is inapplicable. In view of the foregoing, Applicant respectfully requests withdrawal of the rejections and allowance of claims 1, 2, and 5-21.

In the event that some unforeseen issue requires attention, please telephone Applicant's attorney to expedite issuance of the patent. In addition to the aforementioned extension of time, the undersigned authorizes the deduction of any other necessary fees from Deposit Account No. 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', is written over the firm name.

Andrew D. Dorisio
Registration No. 41,713

247 North Broadway
Lexington, KY 40507
(859) 252-0889